

## REMARKS

Claims 1, 2, 4, 5, 7-10, 12, 25 and 26 are presented for consideration, with Claims 1 and 9 being independent.

The specification has been amended to provide a more descriptive title and identify the acronym OSD. In addition, a new abstract is being submitted to better set forth the technical features of the disclosed invention.

With respect to the claims, independent Claims 1 and 9 have been amended to better set forth Applicants' invention. In addition, editorial changes have been made to selected claims, and Claims 25 and 26 have been added to provide an additional scope of protection.

Initially, Applicants respectfully traverse the restriction requirement between the allegedly distinct inventions of Group I and Group II. The inventions of Group I and Group II are said to be distinct because they are related as subcombinations usable together in a single combination and because they have acquired a separate status in the art as shown by their different classification. These contentions are respectfully traversed. It is submitted that the amount of effort required by the Patent and Trademark Office would be lessened by permitting all of the claims presently in the application to be prosecuted in a single application. The alternative is to proceed with the filing of another application, consisting of the same disclosure, and being subjected to substantially the same search, perhaps by a different Examiner on a different occasion, with the resultant burden on the Patent and Trademark Office. Accordingly, it is respectfully requested that the restriction requirement be reconsidered and that all the claims presently in the application be prosecuted in a single application.

Nevertheless, in order to comply with the requirements of 37 C.F.R. §1.143, Applicants hereby confirm the election of Group I, Claims 1-12.

Claims 1 and 9 stand rejected under 35 U.S.C. §103 as allegedly being obvious over Ward '424 in view of Abe (JP '889). Claims 1-5, 7 and 9-12 are rejected under 35 U.S.C. §103 as allegedly being obvious over Dimitrova '124 in view of Abe. Additionally, Claims 6 and 8 are rejected as allegedly being obvious over Dimitrova in view of Abe and Ward. These rejections are respectfully traversed.

Applicants' invention as set forth in Claim 1 relates to an image processing apparatus comprised of input means for inputting first image data and icon image data, determining means for determining a display position of the icon image, and display control means for superimposing one of the first image and the icon image on the other and displaying the first and icon images on a monitor such that the icon image is positioned in the determined display position. As amended, Claim 1 recites that the determining means determines successively a plurality of display positions different from each other as display positions of the icon image, and wherein the plurality of display positions are within a range of a predetermined number of pixels from a predetermined position.

Claim 9 relates to an image processing method and corresponds substantially to Claim 1.

Support for the claim amendments can be found, for example, on page 7, line 21, *et. seq.*, of the specification. In accordance with Applicants' claimed invention, first image data and icon image data can be effectively displayed.

The primary citation to Ward relates to a system for modifying advertisement information on a display. As shown in Figure 1, a television screen display 10 includes picture-in-picture (PIP) windows 12, 14 and 16. By remote controller 26, the PIP windows can be moved on the screen.

The second primary citation to Dimitrova relates to a television receiver having a so-called “smart” picture-in-picture (PIP). A controller 26 analyzes content of a video signal forming a main picture and is capable of automatically adjusting the size and position of the PIP image so it does not obscure an important portion of the main picture.

The secondary citation to Abe relates to a display controller having a screen saver with a screen burning prevention function. The Office Action relies on Abe for teaching a window that can be moved and sized at random.

In contrast to Applicants’ claimed invention, however, it is submitted that none of the patents discussed above teach or suggest, among other features, determining successively a plurality of display positions different from each other as display positions of the icon image, with the plurality of display images being within a range of a predetermined number of pixels from a predetermined position. In accordance with Applicants’ claimed invention, the icon image is displayed in a manner not taught or suggested by the cited art.

Accordingly, it is respectfully submitted that neither Ward nor Dimitrova, whether taken individually, in combination with Abe or even in combination all together, teaches or suggest Applicants’ invention as set forth in independent Claims 1 and 9. Therefore, reconsideration and withdrawal of the rejections under 35 U.S.C. §103 are deemed to be in order and such action is respectfully requested.

Therefore, it is submitted that Applicants’ invention as set forth in independent Claims 1 and 9 is patentable over the cited art. In addition, dependent Claims 2, 4, 5, 7, 8, 10, 12, 25 and 26 set forth additional features of Applicants’ invention. For example, claims 25 and 26 set forth that the plurality of display positions of the icon image are within a range of a

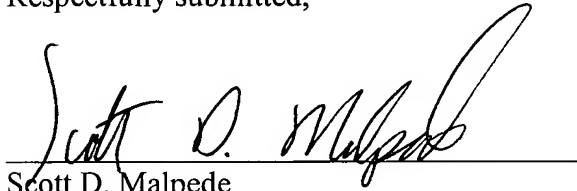
predetermined number of pixels that is smaller than a display surface area of the monitor.

Independent consideration of the dependent claims is respectfully requested.

In view of the foregoing, reconsideration and allowance of this application is deemed to be in order and such action is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott D. Malpede", is written over a horizontal line.

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